



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/709,930	09/09/1996	PHILIP S. GREEN	000287-00482	7111

20350 7590 07/09/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

GARLAND, STEVEN R

ART UNIT PAPER NUMBER

2125

DATE MAILED: 07/09/2004

58

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/709,930

Applicant(s)GREEN, PHILIP S. **Examiner**

Steven R Garland

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003 and 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 115, 119-126 and 161-165 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 115, 123-126, 161 and 162 is/are allowed.
- 6) ☒ Claim(s) 119-122 and 163 is/are rejected.
- 7) ☒ Claim(s) 164, 165 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>54, 57</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The status of the claims is as follows:

Claims 115, 119-126, and 161-165 are pending.

Proposed claims 152-160 have not been entered. These claims were proposed during interference, but were not entered during interference proceedings by the administrative patent judge.

Claims 1-114, 116-118, and 127-151 have been canceled.

2. The drawings are objected to because of the reasons set forth on the PTO-948 form attachment to Paper No. 8. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Claim 163 is rejected under the doctrine of res judicata.

Claim 163 corresponds exactly to former claim 139. Claim 139 was objected to as being dependent on rejected claim 138 at appeal and which rejection of claim 138 was affirmed in the decision of Board of Patent Appeals and Interferences of 12/22/00. After the decision however applicant did not place claim 139 in independent form prior to the time at which the proceedings were terminated. See 37 CFR 1.197. Applicant's arguments have been fully considered in regards to a rejection under res judicata, however applicant failed to prosecute the subject matter of claim 139 prior to the proceedings being terminated and applicant can not now present a new claim for the subject matter of previous claim 139.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 119-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk 5,217,003 in view Heer et al. (as cited by applicant on the IDS statement filed 12/6/02 and which contains the article Endocorporeal Surgery Using Remote Manipulators by Rasor et al. on pages 483-492).

Wilk teaches a robotic surgical system with an arm, controller, and coupler. See the figures; col. 1, line 51 to col. 2, line 16; col. 2, line 33 to col. 3, line 64; and the claims.

Wilk however does not specifically state that proportional movement is accomplished, that an articulable endoscopic instrument is used or that a cauterizer is used.

Heer et al. teaches a surgical robotic system with an arm, coupler, articulable endoscopic surgical instrument, controller, handle, proportional movement, and cauterizer. See pages 488-492 and figures 10 and 11.

It would have been obvious to one of ordinary skill in the art to modify Wilk in view of the teaching of Heer and use proportional movement for ease in control; use an articulable endoscopic instrument for more precise control and use a cauterizer to stop bleeding. This combination of features would allow greater ease in use and also reduce injury to the patient.

In response to applicant's arguments, Heer teaches that the slave arms and arms should faithfully follow the master movements. See pages 490- 491 and note page 490, lines 9-13 and lines 29-50. Further Wilk teaches generating motion outside the body and Heer teaches generating motion inside the body such as by use of an articulable instrument and it would have been obvious to one of ordinary skill in the art to combine Wilk in view of Heer so as to provide greater flexibility in positioning and prevent injury to the patient.

6. Claims 115, 123-126, and 161 are allowed.

7. Claims 164 and 165 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. In regards to the information disclosure statement filed 12/29/03. The information disclosure statement listing various papers from various court cases have been considered, but the documents listed on it have been crossed off so that they will not listed on the face of any patent issuing from the instant application. Also the documents listed on this form are not published documents and some appear to be directed to litigation. If applicant really desires that these documents, including the ones related to litigation, be listed on the face of any patent issuing from the instant application then it is requested that applicant specifically request that they be published in response to this office action. Further it is uncertain as how sheets listing documents were intended to be submitted. The forms state (left hand top) that there are 5 sheets, but only sheets 3 of 5, 4 of 5 , and 5 of 5 were submitted. The sheet numbering has been corrected by the examiner to sheets 1-3 of 3 sheets respectively to avoid confusion as to the number of submitted sheets. If 5 sheets were intended to be submitted then sheets 1 of 5 and 2 of 5 were not submitted.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

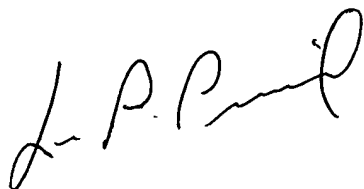
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R Garland whose telephone number is 703-305-9759. The examiner can normally be reached on Monday-Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on 703-308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SRG
Steven R Garland
Examiner
Art Unit 2125

LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100